

PATENT

App. Ser. No.: 10/757,792
Atty. Dkt. No. ROC920030266US1
PS Ref. No.: IBMK30266

REMARKS

This is intended as a full and complete response to the Office Action dated March 31, 2006, having a shortened statutory period for response set to expire on July 1, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-20 are pending in the application and remain pending following entry of this response. Applicants submit that the amendments to the claims presented herein do not introduce new matter.

Claim Rejections - 35 U.S.C. § 103

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fairchild et al.* (U.S. Patent No. 6,728,760, hereinafter "*Fairchild*") in view of *Sidana* (U.S. Patent No. 6,571,295).

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

The present rejection fails to establish at least the third criterion. For example, the references, even when combined as suggested in the Office Action, fail to teach the use of policies that determine how an annotation should be applied to different versions of the same document, as recited in independent claims 1, 13, and 17.

PATENT

App. Ser. No.: 10/757,792
Atty. Dkt. No. ROC920030266US1
PS Ref. No.: IBMK30266

Such version policies, as recited in the claims, may allow a user to control not only whether annotations are to be applied to subsequent versions of the same annotated document, but how the annotations are applied (e.g., if validation should be received from the user that the annotation should be applied, as recited in claim 7). In contrast, Fairchild teaches no such policies to control over how annotations are applied to different versions of the same document. Fairchild only teaches the use of an annotation record that includes "an indication enabling version control of the media item" (see col. 2, lines 43-44), presumably an indication of a version of the media item. The only mention of the term "version" at all in *Sidana* is with reference to a preferred version of Browser (see col. 5, lines 7-9).

The references, even when combined as suggested in the Office Action, also fail to teach "determining if the annotation should be applied to the document as changed, by determining whether a creator of the annotation specified the annotation should be applied to subsequent versions of the document", as recited in independent claim 8.

Accordingly, Applicants submit that claims 1, 8, 13, and 17, as well as their dependents, are allowable and withdrawal of this rejection is respectfully requested.

PATENT

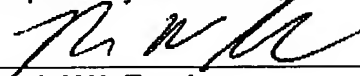
App. Ser. No.: 10/757,792
Atty. Dkt. No. ROC920030266US1
PS Ref. No.: IBMK30266

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Randol W. Read
Registration No. 43,876
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)